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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,378	04/20/2004	Santanu Dutta	9301-84	4824

7590 10/19/2004

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EXAMINER	
D AGOSTA, STEPHEN M	

ART UNIT	PAPER NUMBER
2683	

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/828,378	DUTTA ET AL.	
	Examiner	Art Unit	
	Stephen M. D'Agosta	2683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 9-28-2004 have been fully considered but they are not persuasive1.

1. The applicant has provided information to overcome the examiner's objection to the Oath/Declaration.

2. The applicant argues that the pending claims are patentably distinct from claims 1-305 in US 6,684,057 which are commonly assigned. The examiner disagrees for several reasons:

a. Firstly, the applicant freely acknowledges that the '057 patent and the present application "...both deal with a communications system that reduces interference between a mobile and satellite and/or cellular BTS whereby said mobile unit re-uses the satellite frequency bands to communicate with either the satellite or cellular BTS's..." (page 4 of the fax dated 9-28-04). The term "re-use" can be interpreted in several ways, one of which is that a plurality of channels are available and a user can hand-off from one to any other channel and/or a user can remain on one channel while making changes to their transmission (eg. power control).

b. The Official Action stated:

Claims 1-44 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-305 of U.S. Patent No. 6,684,057. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims deal with a communications system that reduces interference between a mobile and satellite and/or cellular BTS whereby said mobile unit re-uses the satellite frequency bands to communicate with either the satellite or cellular BTS's. Hence the claims are focused on reducing interference either by handing-off or through the use of an "interference reducer". In each case, the uplink/downlink signals are monitored and appropriate action is taken as dictated by the system.

What the applicant fails to understand is the examiner's interpretation of their previous patent US 6,684,057 and the current application under review – the last sentence from the action above states that "In each case, the uplink/downlink signals are monitored and appropriate action is taken as dictated by the system" which shows common workings of both the patent and the application (not to mention the other

similarities based on the applicant's admission from #1 above). The term "action taken" reflects the fact that a cellular system uses both power control and hand-offs to another nearby cell to reduce interference. There are well known and inherent features of a cellular system.

c. Secondly, the application (claim 1) teaches power control threshold monitoring (eg. power control) as does the '057 Patent, see claims 36-37 which disclose the phone transmitting at lower/higher power (which infers changing power based on operating conditions). Hence these claims are obvious type double patenting claims. Further to this point, the '057 patent (claim 43) teaches avoiding interference by selecting certain frequencies to use which reads on a "handoff" (since a user is forced to change frequency).

4. The examiner's use of the word "OR" in the first action was also incorrectly interpreted by the applicant (eg. they state "..by using the word "OR" the action appears to concede that two different techniques are being claims..."). The examiner disagrees with their position - the system/method disclosed in both the patent and the application can be interpreted as being from the same patent since one skilled would first attempt to reduce interference and then (naturally) hand-off if/when the '057 patent teachings did not rectify the problem any more/better. Therefore the examiner interprets this as tying together both the '057 patent and the present application – hence the '057 is novel material but the handing off process is viewed as an extension (eg. double patent) since it does not add additional novel material. Again, what would occur in every situation when the "interference avoidance method" of the '057 patent cannot provide any more interference avoidance -- the answer is always "handoff to another cell".

5. Lastly, the examiner gave considerable thought to his Double Patenting position regarding the '057 Patent and the present application and stands by this position. The applicant should reconsider filing a terminal disclaimer which may provide a more favorable outcome.

6. The rejection now only reflects a Double Patenting rejection (as stated in #2 above).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-34 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-305 of U.S. Patent No. 6,684,057.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims deal with a communications system that reduces interference between a mobile and satellite and/or cellular BTS whereby said mobile

unit re-uses the satellite frequency bands to communicate with either the satellite or cellular BTS's. Hence the claims are focused on reducing interference either by handing-off or through the use of an "interference reducer". In each case, the uplink/downlink signals are monitored and appropriate action is taken as dictated by the system.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen D'Agosta
10-6-04

WILLIAM TROST
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